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REMARKS

The amendments and remarks presented herein are believed to be fully responsive to the Office Action dated January 26, 2005. In light of the above amendments and following remarks, Applicant respectfully requests reconsideration of the present application. The amendments and remarks presented herein are fully supported by the application as originally filed. No new matter has been added.

A petition and fee for a three-month extension of time is being filed concurrently with this Response.

STATUS OF THE CLAIMS

Claims 1-14, 16, 17 and 19-37 are pending in the application. Claims 15 and 18 have been cancelled herein without prejudice. Claims 5, 14, and 16 have been amended as set forth above. Claims 36 and 37 have been added herein.

SPECIFICATION

The specification has been amended to correct a typographical error found in the specification at paragraph 7 of the Detailed Description of the Preferred Embodiments.

CLAIM REJECTIONS

Claims 1-8 and 12-24 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Fowler et al. (Publication No. U.S. 2002/0026348) in view of Fertig (U.S. Patent No. 6,050,493).

Applicant respectfully traverses. To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation either in the references themselves or in the knowledge generally available to one of ordinary skill in the art to modify the reference or combine the reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference or references when combined must teach or suggest all the claimed limitations. The teaching or suggestion to make the claim combination and reasonable expectation of success must both be found in the prior art and not based on Applicant's disclosure. *In re Vaack*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). See MPEP § 2143.

Applicant respectfully urges that there is no motivation or suggestion to combine the marketing method and system of Fowler with the pre-paid gift card of Fertig since such a combination would change the principle operation of the marketing program of Fowler.

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Examiner states "Fowler et al. disclose systems and methods permitting individual merchant and merchant groups to run one-to one marketing programs between one or more selected customers or customer groups, at the point-of-transaction, with awards determined, credited, delivered, and redeemed in real time." (See Col. 2 [0015]) The marketing program method and system of Fowler "enable merchants to effectively target marketing, incentives, and offers to create a more loyal and profitable customer base." (See Col. 2 [0015]). In contrast, as noted by Examiner, "Fertig discloses a pre-paid card (See Col. 1 Line 5-7) for ordering flowers or some other type of gift item." However, the Examiner concludes it would be obvious to combine the references to meet Applicant's claimed invention. Applicant respectfully urges that this is a hindsight reconstruction of the references based on Applicant's own teachings, and not the teachings of the references. Thus, such a modification would not be obvious. *In re Gordon*, 733 F.2d 900, 221 U.S.P.Q. 1125 (Fed. Cir. 1984).

Notwithstanding, Applicant respectfully urges that even when combined, U.S. Publication No. 2002/0026348 to Fowler et al. (hereinafter "Fowler") and U.S. Patent No. 6,050,493 to Fertig (hereinafter "Fertig") does not disclose, teach, or suggest the claimed combination of Claim 1. Examiner conceded that "Fowler et al. fail to teach distributing a product card including product and card information, collecting revenue from a purchaser of the card, and activating the card when the card is purchased so that the card can be redeemed." In addition, the combination of Fowler and Fertig does not disclose or suggest "storing the product and card information in a computer system" and then "activating the card when the card is purchased so the card can be redeemed" after "collecting revenue from a purchaser of the card," as called for in Claim 1 and its dependent claims. Neither Fowler nor Fertig, alone or in combination, provide a multiple-step process for storing product and card information in a computer system and then activating a product card for the purpose of selling and delivering a product, as provided in Applicant's claimed invention.

Accordingly, Applicant respectfully submits that combination of Fowler and Fertig, does not disclose, teach, or suggest all of the limitations called for in Claim 1 or its dependent claims.

With respect to Claim 2, Applicant submits that neither Fowler nor Fertig, alone or in combination, discloses, teaches or suggests all of the claimed limitations for at least the reasons set forth above in reference to Claim 1. Examiner states Fowler in view of Fertig discloses "distributing a product card with product and card information" and "storing the

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product identification code and the card identification code in a computer system (See Col. 7 [0054] in Fowler et al.)." However, Applicant respectfully submits that Fowler and Fertig, alone or in combination, do not show "distributing a product card with product and card information" and "storing the product identification code and the card identification code in the computer system," as in Claim 2 of Applicant's claimed invention. In Fowler at Col. 2 [0054], a point of transaction device 14 "captures transaction data related to customer's transaction, as well as one or more customer identifier(s)," such as a transaction card number, or a program identification number, and not product and card information as provided in Applicant's claimed invention. Applicant submits both Fowler and Fertig, alone or in combination, are silent as to "storing the product identification code and the card identification code in the computer system," as provided in Claim 2. Therefore, Applicant respectfully submits that neither Fowler nor Fertig, alone or in combination, discloses or suggests all of the claimed combinations of Claim 2 of Applicant's claimed invention.

With regard to Claim 3, Applicant respectfully submits that Fowler in view of Fertig does not disclose or suggest the claim limitation of activating the card by storing an active status code in the computer system with the card identification code. Fowler, at Col. 5 [0037], provides "gift certificates may be issued in the currency or currencies of an awards program" and "may be redeemable ... at participating merchants. Data relating to the unique gift or award recipient identifier, and the type or amount of the gift or award, is communicated to and stored at the host controller system." In Applicant's claimed invention, the product card, which first has its product and card information stored in the computer system, is activated by "storing an active status code in the computer system with the card identification code." The combination of Fowler and Fertig does not disclose or suggest activating the product card by storing an active status code in the computer system with the card identification code, where product and card information has already been stored in the computer system as in Applicant's claimed invention. Applicant's claimed invention includes two separate and distinct steps of first validating the card by storing the information into the computer system and then another separate step of activating the card to complete the sale and delivery of a product. Therefore, Applicant submits the combination of Fowler and Fertig does not disclose or suggest all of the claimed limitations of Claim 3 of Applicant's claimed invention.

Regarding Claim 4, Applicant urges that neither Fowler nor Fertig, alone or in combination, discloses or suggests "determining the activation status code of the card based

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on the product and card information; and if the card is activated then inputting the delivery information into the computer system." In Applicant's claimed invention, the product and card information must first be stored in the computer system before the product card can be activated in order to sell and deliver a product.

The combination of Fowler and Fertig is silent as to the steps of "determining the activation status code of the card based on the product and card information and if the card is activated then inputting the delivery information into the computer system." Fowler provides a marketing method and system which allows merchants to effectively target marketing incentives and offers to create a more loyal and profitable customer base. Fowler permits "merchants and merchant group(s) to run one-to-one marketing programs between one or more selected merchant(s) and one or more selected customer(s) or customer group(s), at the point-of-transaction, with awards determined, credited, delivered, and redeemed in real time." (See Col. 2 [0015]). Accordingly, both Fertig and Fowler, alone or in combination, do not disclose or suggest "determining the activation status code of the card based on the product and card information; and if the card is activated then inputting the delivery information into the computer system." Therefore, Applicant submits the combination of Fowler and Fertig does not disclose or suggest the claimed combination of Applicant's claimed invention in Claim 4.

Claim 5 has been amended to be in independent form. Applicant submits that neither Fowler nor Fertig, alone or in combination, discloses or suggests "determining whether the product and card information is stored in said computer system to determine whether the card is valid." Fowler, at Col. 1 [0003], provides "real-time, automated marketing programs" that "calculate benefits to customers based on one or more" identifiers or behaviours and "analysis of transaction data." Fertig, on the other hand, provides a pre-paid gift card activated at the point-of-sale and does not perform an initial determination of the validity of their pre-paid gift card. Accordingly, Fertig and Fowler, alone or in combination, do not provide, teach or suggest the claimed limitation of "determining whether the product and card information is stored in the computer system to determine the product card is valid," as provided in Claim 5 of Applicant's claimed invention.

Regarding Claim 8, Applicant submits the combination of Fowler and Fertig does not disclose or suggest providing a product card that is encoded with card and product identification codes associated with the product and card information, as required in Claim 8 of Applicant's claimed invention.

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Examiner cites Fowler, at Col. 4-5 [0032], which provides "marketing programs specific to individual merchants and/or merchant groups through existing customer identifier(s), such as those encoded electronically in existing credit cards, debit cards, loyalty cards, and the like." However, the encoded cards disclosed in Fowler provides customer identifiers for a marketing rewards program and is completely silent as to encoding a product code with a card and product identification codes, as in Applicant's claimed invention. Accordingly, Applicant respectfully submits that the combination of Fowler and Fertig does not teach, suggest or provide a product card encoded with card and product identification codes associated with the product and card information for a method of selling and delivering a product.

Applicant has amended Claim 14 as follows:

A method of selling and delivering a product, said method comprising:

providing a computer system;

distributing a product card to a retailer, the product card encoded with a product identification code and a card identification code;

after receipt by the retailer communicating the product identification code and the card identification code of the product card to the computer system, the computer system having the product identification code and the card identification code stored therein, and said communicating validating the product card;

displaying the validated product card in a retail establishment, the product card including an illustration of the product associated with the product identification code;

collecting revenue from a purchaser of the card;

activating the validated product card either (a) when or after said card is received by a retailer or (b) when the card is purchased, the validated product card being activated when the product identification code and the card identification code of the validated product card is communicated to the computer system so that the product card can be redeemed;

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receiving the product identification code, the card identification code, and the delivery information from a redeemer of the validated and activated product card;

inputting the delivery information into the computer system; and

delivering a product associated with the product identification code of the validated and activated card to a location associated with the delivery information.

Applicant's amended Claim 14 clarifies the multiple steps for the method for selling and delivering a product of the present invention. A product identification code and a card identification code, encoded on a product card, are communicated to validate the product card. After revenue is collected from a purchaser of the validated product card, the card is activated when the product identification code and the card identification code of the validated product card is communicated to the computer system, so that the product card can be redeemed. Applicant's claimed invention requires the distinct and separate steps of communicating product and card information to the computer system to validate the card and then activating the validated product card by communicating the activation to the computer system.

Examiner cites Fowler to show "systems and methods permitting individual merchants and merchant groups to run one-to-one marketing programs between one or more selected merchants and one or more selected customer groups, at the point-of-transaction, with awards determined, credited, delivered, and redeemed in real time (See Col. 2 [0015]). Transaction card number and customer ID data are transmitted to a merchant in-house operating system where data is stored and analyzed (See. Col. 7 [0054]). Then, the gift or award is redeemed at any participating merchant, and redemption of the gift or award is communicated to and stored by the host controller system using point of transaction device from the redeeming merchant (See Col. 5 [0037]). In a preferred real time system implementation, information such as updated award information or customer information may be transmitted to the remote transaction system for delivery to the customer and/or merchant (See Col. 3 [0020]).

In contrast, in Applicant's amended Claim 14, the method of selling and delivering a product includes a multiple step process of first "communicating the product identification code and the card identification code of the product card to the computer system" and then "activating the validated product card either (a) when or after said card is received by a

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retailer or (b) when the card is purchased." The combination of Fowler and Fertig is silent as to a product card, where the product and card information must first be communicated to the computer system for validation and then activated in order to sell and deliver a product.

Therefore, Applicant submits that the combination of Fowler and Fertig fails to disclose, teach or suggest all of the claimed combination of amended Claim 14 or its dependent claims, namely Claims 15-24.

Claims 9-11 rejected under 35 U.S.C. §103(a)

Claims 9-11 were rejected under 35 U.S.C. §103(a) as being unpatentable over Fowler in view of Fertig as applied to Claim 1 above and further in view of Kazaks et al. (Publication No. U.S. 2002/0046341, hereinafter "Kazaks"). Applicant submits the combination of Fowler, Fertig, and Kazaks does not disclose "encoding the card with a retail store code associated with a retail location where the product card is distributed", "providing a product card encoded with a dollar amount associated with the product card", or "providing a product card includes providing a product card with encoded with a retail store code, said dollar amount associated with said retail store code," as provided in Claims 9-11.

Examiner states Kazaks discloses that information of the location of the store, the time and date, and the account number is coded, at Col. 4 [0040], for activation, the amount of charged is encoded in an accessible bar code, price tag, or other system for billing, at Col. 4 [0043], and a binary identification number is a two-part code assigned to banks and sales terminal for database, at Col. 4 [0040]. However, Kazaks provides a method and system for issuing and using anonymous and pseudo-anonymous pre-paid payment cards with the existing credit card and debit card infrastructure. In Kazaks, a customer buys a card, and the clerk swipes the pre-paid payment card as if charging the amount to a regular credit card. The transaction is declined by the bank and a special decline code is sent back to the retailer. This decline creates a record that contains the location of the store, the time and the date, the account number, and the decline message that was returned. Next, the user logs onto a web site of the card sponsor and enters his or her deposit code number to run against the database, where it is associated with a bank identification number and an account number. If the record contains the decline of the right type, the location that the card was shipped to, the account is activated and the associated value is loaded. The user then fills in his or her personal anonymous or pseudo-anonymous information via the web.

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Accordingly, Kazaks provides a method and system of issuing anonymous pre-paid credit cards using the existing credit card and debit card infrastructure. Kazaks does not provide encoding a product card with a retail store code, a dollar amount, or both, as provided in Claims 9-11 of Applicant's claimed invention. Therefore, Applicant submits that the combination of Fowler, Fertig, and Kazaks does not disclose or suggest the claimed limitations of Claims 9 through 11 of Applicant's claimed invention.

Claims 25-35 rejected under 35 U.S.C. §103(a)

Claims 25-35 were rejected under 35 U.S.C. §103(a) as being unpatentable over Fowler et al. in view of Fertig and Kohler et al. (Publication No. U.S. 2002/0032668, hereinafter "Kohler").

With respect to Claim 25, Applicant respectfully urges none of Fowler, Fertig, and Kohler discloses or suggests the claimed combination. For example, none of Fowler, Fertig, and Kohler discloses or suggests a computer system storing data information about the product card, such as card identification information and product identification information about the product associated with the card and "storing an active status code" for the card when the card is read by a processor. Therefore, Applicant respectfully submits that the combination of Fowler, Fertig, and Kohler does not disclose, teach or suggest the claimed combination of Claim 25. Moreover, as previously stated, there is no motivation or suggestion to combine the marketing method and system of Fowler with the pre-paid gift card of Fertig to meet the claim limitations of Claim 25 of Applicant's claimed invention. Therefore, Applicant respectfully submits the combination of Fowler, Fertig, and Kohler does not disclose, teach or suggest all of the claimed combination of Claim 25 or its dependent claims, Claims 26-35.

Accordingly, in light of the above amendments and remarks, Applicant respectfully requests reconsideration of the present application and a Notice of Allowance of all claims, namely Claims 1-14, 16, 17, and 19-37. Should the Examiner have any questions or comments, the Examiner is invited to contact the undersigned at (616) 975-5506.

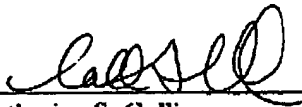
Respectfully submitted,

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